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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,325	07/26/2000	JOHN S. YATES JR.	114596-28-0053BS	7939
38492	7590	10/14/2005	EXAMINER	
WILLKIE FARR & GALLAGHER LLP INTELLECTUAL PROPERTY LEGAL ASSISTANTS 787 SEVENTH AVE NEW YORK, NY 10019-6099			ELLIS, RICHARD L	
			ART UNIT	PAPER NUMBER
			2183	

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/626,325

Applicant(s)

YATES ET AL.

Examiner

Richard Ellis

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s): _____.
13. ☐ Other: _____.



**RICHARD L. ELLIS
PRIMARY EXAMINER**

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1. 37 CFR § 1.181(c) reads as follows (emphasis added):

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. ...

2. Applicant's petition under 37 CFR § 1.181 has been submitted without there having been a proper request for reconsideration filed, and as such is being treated instead as a request for reconsideration.

3. In the request for reconsideration, applicant requests reconsideration of two points:

A. "Did the examiner err in objecting to the Amendment Accompanying RCE" of April 27, 2005 as 'new matter?'"

B. "May this first Office Action after an RCE be made final?"

4. To reiterate from the last office action, paper number 20050714, mailed July 19, 2005, applicant cited the case of *Schering Corp. v. Amgen, Inc.* as his sole basis for support for insertion of the new matter into the specification. However, as clearly pointed out in the last office action, the above case states this requirement:

Thus, to avoid the new matter prohibition, an applicant must show that it's original application supports the amended matter." (*Schering Corp. v. Amgen Inc.*, 55 USPQ2d 1650, citations omitted, emphasis added.)

5. As was clearly pointed out in the last action, applicant's amendment merely cited this court case as giving him the right to add the new matter, while giving absolutely no explanation as to how or why the case gave him this supposed right. Additionally, the amendment completely failed to **show** in any way, shape, or form, how applicant's

original application supported the amended matter. The presumption must therefore be, that applicant's original application does not support the amended matter, because if it did contain support, applicant would have pointed to such support.

6. Applicant next attacks the examiner's definition of thread, alleging that the examiner's "... relies on an extrapolation of his own devising ..." and that the examiner's definition is "... not found in any dictionary ..." (emphasis unchanged). These two allegations by applicant are blatantly false, because the definition utilized by the examiner is indeed found in a dictionary, it is found in the *Microsoft Press Computer Dictionary, second edition* and not only is it found in the second edition, but is also found in the third and fourth editions as well. Accordingly, because the definition is found in a dictionary, rendering applicant's second allegation false, the definition is not of the examiner's "own devising" because the examiner did not devise the definition, an employee of the Microsoft corporation devised of the definition, which renders applicant's first allegation false.
7. Applicant further attacks the Microsoft dictionary definition as obsolete, however, the definition quoted to applicant from the second edition has survived through the third and fourth editions of the same dictionary with no change to the portion relied upon by the examiner. Below are quotations from the second, third, and fourth editions of the Microsoft dictionary for applicant's convenience in reference. Copies of the relevant page of the third and fourth editions are enclosed for applicant's pursual:

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second edition, copyright 1994	<p>memory.</p> <p>thread In programming, a process that is part of a larger process or program.</p> <p>In a tree data structure, a pointer that identifies the parent node and is used to facilitate traversal of the tree.</p> <p>threaded tree A tree in which the leaf (end) nodes contain pointers to some of the nodes from the facilitate</p>
third edition, copyright 1997	<p>thread \thred\ <i>n.</i> 1. In programming, a process that is part of a larger process or program. 2. In a tree data structure, a pointer that identifies the parent node and is used to facilitate traversal of the tree. 3. In electronic mail and Internet newsgroups, a series of messages and replies related to a specific topic.</p> <p>threaded discussion \thread'ed diskush'ən\ <i>n.</i> In</p>
fourth edition, copyright 1999	<p>thread <i>n.</i> 1. In programming, a process that is part of a larger process or program. 2. In a tree data structure, a pointer that identifies the parent node and is used to facilitate traversal of the tree. 3. In electronic mail and Internet newsgroups, a series of messages and replies related to a specific topic.</p> <p>threaded discussion <i>n.</i> In a newsgroup or other</p>

8. As can be clearly seen from the above sections of the three editions of the Microsoft dictionary, the only change to the definition of thread (beyond reformatting of the paragraph) is the addition of a third meaning to encompass the electronic mail and newsgroup meaning of "thread". However, the definition relied upon by the examiner, the first definition, has remained unchanged, and is word for word identical in all three editions of the dictionary. Therefore, the second edition definition is hardly obsolete when the fourth edition definition is exactly identical to the second edition definition.

9. If applicant has a complaint with the definition of thread published by Microsoft then applicant's arguments should be directed to Microsoft, not to the US Patent Office. The contact information for the Microsoft Press is:

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Microsoft Press
A division of Microsoft Corporation
One Microsoft Way
Redmond, Washington, 98052-6399

10. Applicant also cites numerous supporting dictionary quotations that he asserts support his definition of thread over that of the Microsoft corporation. Applicant is again reminded of the following:

"Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation." In re Morris, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997).

11. As applicant has no express definition for "thread" in their specification, the mere fact that applicant can cite to other dictionaries has not, in and of itself, rendered the definition provided by the Microsoft computer dictionaries unreasonable. The Microsoft computer dictionaries indicate a reasonable definition for "thread" and as such, applicant must amend his claims to narrow their scope, not attempt to insert new matter into the specification in an improper attempt to change the scope of his claims.

12. Applicant further argues that all the definitions he supplies either state concurrency, or inherently require concurrency in the definition of thread. However, applicant is incorrect in that argument. While several of applicant's definitions do state a concurrency requirement as part of the definition of "thread", other definitions make no such requirement. For example, applicant's own definition from *The Authoritative Dictionary of IEEE Standards Terms*, 7th ed. (2000)(Exhibit A) includes no such requirement for concurrency in the definition of threads. Applicant relies upon the statement "scheduling priority and policy" in the IEEE definition of "thread" to imply an

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inherent concurrency to "thread". However, this reliance exposes a fundamental misunderstanding of the meaning of "concurrency" and "scheduling".

concurrent 1: operating or occurring at the same time. 2 a: convergent: *specif*: meeting or intersecting at a point b: running parallel 3: acting in conjunction 4: exercised over the same matter or area by two different authorities (*Webster's Ninth New Collegiate Dictionary*, 1990)

concurrent: pertaining to the occurrence of two or more activities within a given interval fo time (B) cf. consecutive, sequential, simultaneous (*Dictionary of Computers, Information Processing & Telecommunications*, 2nd edition, Jerry M. Rosenberg, editor, 1987)

13. As seen from the above, concurrent means performing a plurality of actions at the same time, or in parallel. If, as applicant asserts, the statement "scheduling priority and policy" inherently meant concurrent (meaning required to be performed at the same time or in parallel) then because the tasks were being performed in parallel at the same time, there would be no need to "schedule" the tasks. If everything is performed in parallel at the same time, the system would simply perform all the tasks in parallel. By "scheduling" the tasks, as indicated by the IEEE dictionary, the dictionary has in fact indicated against an inherent (or required) concurrency, because the need to "schedule" tasks means that they can not all be performed in parallel.

14. Applicant then cites to numerous other dictionary and other publications which he argues support his conclusion that the word "thread" inherently requires "concurrency". Unfortunately, while some of applicant's cited defintions do indicate an aspect of "concurrency" as part of one possible definition of "thread", other citations by applicant contain no such requirement. Applicant's own IEEE definition detailed above is one such example. Applicant's "Wikipedia Definition" citation states that "threads" "**can be**

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executed in parallel. By stating "can be" this definition teaches against inherency because something that "can be" is not "required to be".

15. The result of applicant's extensive showing of dictionary and other teaching definitions of thread is a proof that the term thread has multiple potential meanings in the art, some of which require concurrency, some of which state that concurrency may be required, and some which do not state any requirement for concurrency at all. Applicant is reminded of this citation from MPEP § 2163.07(I) (emphasis added):

The mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter. If there are multiple definitions for a term and a definition is added to the application, it must be clear from the application as filed that applicant intended a particular definition, in order to avoid an issue of new matter and/or lack of written description. See, e.g., *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 1352-53, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000)

16. Applicant has fallen into the trap outlined by the above quotation from the MPEP. Applicant finds himself in a situation where a term in the art has multiple definitions, and he is attempting to add one of those definitions to the application. However, he has failed in any way whatsoever to show that **"it is clear from the application as filed that applicant intended [that] particular definition"**. Until applicant satisfactorially shows that based upon his application as filed, that the one of several definitions that he wishes to add now is the clearly intended definition, applicant can not possibly avoid a new matter objection to the amendment.

17. In fact, applicant's own supporting citations bring this point out to applicant. Applicant argues that cases indicate that case need be exercised in relying upon dictionary definitions and cites at least *Phillips v. AWH Corp.* in support. The very text

that applicant quotes for his support makes this statement:

... There is no guarantee that a term is used in the same way in a treatise as it would be by the patentee ...

... The resulting definitions therefore do not necessarily reflect the inventor's goal of distinctly setting forth his invention as a person of ordinary skill in that particular art would understand it.

18. The predicament that applicant now finds himself in is that the specification as filed did not indicate the inventors' distinct meaning (as indicated is a requirement by the trial judge above), and now, after having filed a flawed specification, applicant's attorney is attempting to ignore the clear prohibition against addition of new matter to a specification in order to correct the fatal flaw which was inserted into the specification at the time it was filed. The time for applicant to have corrected this deficiency was before he filed his patent specification, not now, during prosecution, after he learns that his specification is fatally flawed.
19. Applicant further argues that this first action can not be made final because an information disclosure statement has not been considered. However, as has been pointed out to applicant several times across several different cases, consideration or lack of consideration of an IDS is not a controlling factor in properly making an action final. Furthermore, attached applicant will find the referenced IDS form, indicating consideration of the relevant documents.
20. Applicant concludes by arguing that the claims have not been considered based upon the amendment to the specification. Applicant is reminded that it is the claims which define the invention, not the specification:

The invention disclosed in Hiniker's written description may be outstanding in its field, but the name of the game is the claim. (*In re Hiniker Co.*, 47 USPQ2d 1523,

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1529 (Fed. Cir. 1998))

It is the claims that measure the invention. (*SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fec. Cir. 1985) (en banc))

21. And that importation of limitations from the specification into the claims is also improper:

[Although] it is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim, ... this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By 'extraneous,' we mean a limitation read into a claim from the specification wholly apart from any need to interpret ... particular words or phrases in the claim." (*In re Paulsen*, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994))

22. In this situation, applicant is attempting to import the limitation "concurrent" into the claims from the specification, wholly apart from any need to interpret the word thread in the claim. As has been previously pointed out in this action, the definition of thread in the art takes on plural forms, some which do not require concurrency. Accordingly, applicant must instead narrow the claims to distinctly claim only the concurrency portions of the accepted definitions of thread, and not attempt to change the definition of thread in the specification and then import that limitation into claims that are so broadly written such that they do not require that limitation.


23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Ellis whose telephone number is 571-272-4165. The examiner can normally be reached on Monday-Thursday from 0730 to 1800.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Chan, can be reached on 571-272-4162. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RICHARD L. ELLIS
PRIMARY EXAMINER